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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,985	05/19/2000	Dana W. Wolcott	80724PF-P	9582

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PATENT LEGAL STAFF
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EXAMINER

BROWN, TIMOTHY M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,985

Applicant(s)

WOLCOTT ET AL. S-1

Examiner

Tim Brown

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>7</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. This Final Office Action is responsive to Applicants' Amendment submitted November 22, 2002.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al. (US 6,369,908) in view of Enomoto (US 5,974,401).**

Frey discloses a photo kiosk incorporating a camera, a number of options for creating an electronic file containing digital output from the camera, and a database for maintaining the digital output and associated electronic files for future access. The kiosk includes a touch screen monitor for making selections from a menu of options, and a countdown timer for alerting the user of the preset time for image capture. The camera takes a number of predetermined images of the user and prompts the user to add a banner, text or audio enhancement to the image file. The user can save the file to a removable storage device such as a CD or floppy disk for immediate acquisition, or can enter an email address for electronically forwarding the digital image file to over the Internet. The kiosk cpu will store the file and related customer information in a database, and will transmit the file over the Internet automatically at a later specified time for customer retrieval (see at least col. 3 lines 3-6, and 43-56, col. 4 lines 1-14, col. 5 lines 9-24, 44-55, and 63-67).

Please note that while Frey does not specifically disclose selecting a camera, the act of selecting a camera is inherent to the process of a customer using Frey's photo kiosk, since the kiosk would be useless without a camera. Moreover, the ultimate purpose of selecting any camera is to acquire the images produced by the camera, which is also the purpose of Frey's kiosk and the reason for a customer to pay for the use of the kiosk.

Frey fails to disclose creating and entering an account into a database for a product/service plan, maintaining a product/service record, providing a selected amount of developed film prints, scanning images, or providing services by a photographic service provider. Enomoto teaches a digital print order and delivery system operating over the Internet. The system allows a customer to select a photofinisher from a list, and creates a user account in the system that is accessed by a unique user ID and password. The system includes a scanner for image input, and alternately allows a user to send exposed rolls of film to the selected photofinisher for input to the system. (see at least col. 3, lines 24-26 and 44-46, col. 4 lines 5-51, col. 6 lines 19-22, and col. 8 lines 34-52). It would therefore have been obvious to one having ordinary skill in the art at the time of the invention to combine Frey's photo kiosk with the teaching of Enomoto regarding a print order and delivery service over the Internet. Doing so would increase customer satisfaction by providing remote photofinishing services to camera users. Please note that while Enomoto does not specifically disclose the use of hybrid digital/film cameras, Enomoto teaches providing images from both film and digital cameras. It would therefore have been obvious to provide images to the print ordering

system from a hybrid camera, since both scanned and digital images could be used as input to the system. Please also note that while Enomoto does not teach providing film development for a specified number of film rolls, the act of a customer specifying the number of rolls of film to be developed is old and well known and would have been an obvious service to provide for customers in order to increase profits.

Response to Arguments

4. Applicant's arguments filed November 22, 2002 have been fully considered but they are not persuasive.

5. MPEP § 2111 states "[d]uring patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.'" Given this standard, the Examiner responds as follows.

6. Applicants' argue Frey et al. (US 6,369,908) ("Frey") does not teach selecting a camera because the kiosk disclosed in Frey has its own camera (Amendment, p. 2). The Examiner respectfully disagrees. Claim 1 does not recite selecting a camera from a plurality of cameras. To the contrary, claim 1 simply recites the step of *selecting a camera*. Frey inherently teaches this step in that Frey discloses using a photographic kiosk to capture the image of a user (col. 5, lines 10-25). In order for the kiosk to capture an image of the user, a camera must be selected. Therefore, Frey teaches the step of selecting a camera.

7. Applicants' argue Frey does not teach *selecting a photograph product/service plan from a menu of photographic product/service plans* (Amendment, p. 2). The Examiner respectfully disagrees. Applying the broadest reasonable interpretation to

Claim 1, the step of *selecting a photograph product/service plan from a menu of photographic product/service plans* is simply selecting a photographic product from a menu of photographic products. Given this construction, Frey teaches this step.

According to Frey, a user is permitted to choose between having his image transmitted as an email or having it saved on a storage medium (see col. 3, lines 3-6 and 24-26).

Both a photographic email and a storage medium containing a photographic image are forms of *photographic products*. Therefore, Frey teaches selecting a photograph product/service plan from a menu of photographic product/service plans.

8. Applicants' argue Frey does not teach *associating the selected camera with the selected product/service plan* (Amendment, p. 2). The Examiner respectfully disagrees. Frey discloses selecting a camera as discussed under paragraph 5 *supra*. Frey further discloses using the selected camera to capture an image of the user (Abstract). After capturing the user's image, the user is permitted to select from a number of photographic product options including a storage medium and an email message (*Id.*). The camera is associated with the email and/or storage medium because the camera is used to generate the image to which the email and/or storage medium relates. As discussed *supra*, both photographic emails and a storage media are photographic products. Therefore, Frey discloses associating the selected camera with *the selected product/service plan*.

9. Applicants' argue Frey does not teach *creating a product/service plan account indicia thereof* (Amendment, p. 2). However, the Examiner notes Enomoto was offered for teaching this limitation (see Office Action, p. 3). Specifically, Enomoto discloses a

print order delivery system wherein a user is provided with an ID and password upon completing a print order (col. 4, lines 39-51). The user may then use the ID and password to access his order data (*Id.*). Consequently, Enomoto discloses creating a product account that is indicative of the product. Modifying Frey to include this limitation would provide a means for identifying the user with a product order thereby facilitating the access of order information. Therefore, at the time of Applicants' invention, it would have been obvious to modify Frey to include creating a product account indicia as taught by Enomoto.

10. Applicants argue Frey teaches away from the invention because "virtually all orders are different from each other." (Amendment, p. 3). Applicants further argue "[t]here will be no common plan for providing goods or services with respect to a specific camera." (*Id.*). The Examiner respectfully disagrees.

First, Claim 1 makes no mention of a *common plan* for goods or services. Rather, Claim 1 simply recites "selecting a photographic product/service plan from a menu" Frey discloses selecting a photographic product in that Frey provides a user may choose to transmit his image by email or have it saved on storage medium (Abstract). Thus, Frey does not teach away from Applicants' invention.

Second, assuming Claim 1 relates to a *common plan for goods or services*, Frey discloses as much. According to Frey, each user is permitted to select from the same photographic product options (Abstract). That is, each customer is permitted to choose between having his image sent as an email, or having it saved on a storage medium.

Because each user is provided with the same options, Frey teaches a common plan for goods. Because Frey teaches a common plan for goods, Frey does not teach away from the claimed invention.

11. Applicants argue Enomoto et al. (US 5,974,401) ("Enomoto") does not overcome the deficiencies of Frey because Enomoto is not directed to a particular camera (Amendment, p. 3). However, this argument is moot in that Frey teaches selecting a camera as discussed under paragraph 5 *supra*.

12. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to combine Frey and Enomoto because both disclosures relate to obtaining photographic products over a computer network. Moreover, modifying Frey to include the teachings of Enomoto would permit users to obtain photographic prints in addition to photographic emails and storage media.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown
Examiner
Art Unit 3625


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

TB
January 31, 2003